



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,282	10/25/2005	Alain Lecompte	0510-1126	2996

466 7590 10/12/2010  
YOUNG & THOMPSON  
209 Madison Street  
Suite 500  
Alexandria, VA 22314

EXAMINER
----------

IBRAHIM, MEDINA AHMED

ART UNIT	PAPER NUMBER
----------	--------------

1638

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

10/12/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/554,282	<b>Applicant(s)</b> LECOMPTE, ALAIN	
	<b>Examiner</b> Medina A. Ibrahim	<b>Art Unit</b> 1638	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant's response filed 02/12/10 in reply to the Office action of 08/19/09 has been entered. Claims 1-2 and 8-11 are currently amended. The declaration of Alain Lecompte of 11/19/09 has been considered.

All previous objections and rejections not set forth below have been withdrawn in view of Applicant's amendment to the claims and/or arguments.

Claims 1-12 are pending and are examined.

### ***Claim Rejections - 35 USC § 112***

Claims 1 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is repeated for the reasons of record as set forth in the last Office action of 08/19/09. Applicant's arguments filed 11/19/09 have been fully considered but are not deemed persuasive.

Claims 1 and 4 are indefinite for reciting forcing conditions without specifying the content and concentrations of the nutriment solution; only temperature conditions are recited. The specification does not define what is encompassed by the nutriment solution and the solution is not known in the art. Dependent claims 2-3, 5-7, and 12 do not obviate the rejection, therefore are included in the rejection. The claims were

Art Unit: 1638

inadvertently omitted in the last rejection; the claims depend from rejected claims 1 and 4.

Applicant asserts that the specification discloses the main features of the forcing conditions which are the nutriment solution temperature and room temperature.

Applicant refers to *Leteinturier et al* cited in the reference for description of the composition of the nutriment solution. This is not found persuasive because the content and composition of the nutriment is not known and it is unclear how the temperature can be determined without knowing the composition/content of the nutriment solution itself.

Applicant neither provided a copy of the *Leteinturier et al* reference nor provided a complete citation of the reference. Also, it is unclear if the nutriment solution is the same as NF medium or M4 medium shown on Tables I and II of the specification. Applicant's response does not provide any clarification with regard to the relationship between the nutriment solution of the claims and NF and M4 media of Tables I and II of the specification.

### ***Claim Rejections - 35 USC § 112***

Claims 8-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is repeated for the reasons of record as set forth in the last Office action of 08/19/09. Applicant's arguments and the

declaration of Alain Lecompte under 132 filed 11/19/09 have been fully considered but are not deemed persuasive.

Applicant asserts that the claimed recombinant plants are obtained by the process as set forth in the claims and are described by specific phenotypic features and that the Figures 2-7 of the drawings show the structural features of the plants. Applicant argues that the combination of tuberous roots and indented leaves distinguish the claimed Cichorium-type from previously known Cichorium-type plants. Therefore, Applicant argues that the claimed invention meet the written description requirement (response, pp.19-20).

These are not found persuasive for the following reasons: firstly, according to the MPEP and related case law *Eli Lilly*, the written description of an invention requires **a precise definition, such as by structure, formula [or] chemical name, of the claimed subject matter sufficient to distinguish it from other material**". The MPEP 2163 states, the claimed invention as a whole may not be adequately described where an invention is described solely in terms of a method of its making coupled with its function and there is no described or art-recognized correlation or relationship between the structure of the invention and its function. The tuberous roots and indented leaves are insufficient to describe the claimed plants even if other Cichorium-type plants would not have tuberous roots and indented leaves. In addition, genes that confer the structural characteristics as set forth in the claims are neither known nor described in the specification. Therefore, the instantly claimed invention is not precisely described in

Art Unit: 1638

such a way to sufficiently distinguish the claimed plant from other Cichorium-type plant species.

Applicant contends that the fact that the one or more genetic determinants that confer the phenotypic characteristics of tuberous roots and indented leaves are not known represents features that are not reachable by one skill in the art and that knowledge would only have consisted a distinct way to describe the same claimed plants .

These are not found persuasive because the fact that the genetic determinants that confer the phenotypic characteristics of tuberous roots and indented leaves are neither known in the prior art nor described in the instant specification supports Examiner's position that the claimed invention does meet the written description requirement. The MPEP states that one essential goal of the written description requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed. See, *In re Barker*, 559 F.2d 588, 592 n.4, 194 USPQ 470, 473 n.4 (CCPA 1977).; and another essential goal is to put the public in possession of what the applicant claims as the invention. See *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1566, 43 USPQ2d 1398, 1404 (Fed. Cir. 1997), cert. denied, 523 U.S. 1089 (1998). Therefore, the written description requirement implements the principle that a patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor's obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed. Furthermore, the written

description requirement promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. Also, .see *Capon v. Eshhar*, 418 F.3d 1349, 1357, 76 USPQ2d 1078, 1084 (Fed. Cir. 2005).

Applicant also argues that the description of a plant by their phenotypic characteristics is a conventional way of defining the plant characteristics and that the plant breeder's right description requirement concern only phenotypic features of the novel variety. Applicant provides UPOV guidelines of three *Cichorium* species to support this position. Applicant, therefore, requests withdrawal of the rejection (response pp. 221-23).

These are not found persuasive because the current application is filed under 35 USC 111 (plant utility application) and **not filed** under 35 USC 1.161 (only for asexually reproduced plant varieties) , therefore, the written description requirement for plant patent utility applications and the written description requirement for PLT applications (asexually reproduced plant varieties) have different rules and guidelines. See MPEP 1601-1612 for PLT applications and MPEP 2163 for the written description requirement of plant patent utility application.

Therefore, the recombinant *Cichorium* plants produced by the above method are described by phenotypic characteristics only and not by phenotypic and genotypic characteristics. See the MPEP 2163 and related case law *Eli Lilly* cited in the last Office action. Neither the prior art nor the instant specification provides evidence that the

Art Unit: 1638

genes responsible for the phenotypic characteristics that belongs to class PPI, GPI, TFR, and SCA are known. Therefore, since the plants are not described both phenotypic and genotypic characteristics, the written description requirement is not satisfied.

The Declaration of Alain Lecompte under 37 CFR 1.132 filed 11/19/09 is considered but is not found persuasive for the reasons set forth above.

***Remarks***

No claim is allowed.

The claims are deemed free of the prior art of record.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



### **Contact information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Medina A. Ibrahim whose telephone number is (571)272-0797. The examiner can normally be reached on M-TH 8:00 am to 5:30 PM, and every other Friday from 8:00 AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on 571-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MAI  
10/1/2010

/Medina A Ibrahim/  
Primary Examiner, Art Unit 1638